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10/730,691	12/08/2003	Mark W. Bergman	B787.12-0008	4310

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EXAMINER
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BAREFORD, KATHERINE A

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/730,691

Applicant(s)

BERGMAN ET AL.

Examiner

Katherine A. Bareford

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1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

*Claims 1 and 22-24 are canceled*

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's request for RCE filed on April 21, 2005 has been entered.

The amendment of May 23, 2005 (in response to the Notice of Non-Compliant Amendment) has been entered and considered. The Examiner also notes the affidavits filed May 23, 2005 and April 21, 2005.

It is noted that claims 1 and 22-24 have been canceled, leaving claims 2-21 pending for examination.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Armstrong (US 4927046) in view of Zebrowski (US 5836469).

Claim 1: Armstrong teaches a method for securing a users hand to a container. Figures 1 and 6 and column 2, lines 40-45. The container has an outer surface and an inner surface. Figure 1 (note area 1 and area 7). The inner surface defines a cavity therein. Figure 1. A supportive handle is provided which is an integral part of the container body. Figure 5 and column 4, lines 15-35. To hold the container, the hand of the user is inserted between the handle and the outer surface of the container, so that the hand grips the handle. Figures 1 and 6 and column 3, lines 1-15. A fluid applicator tool is provided. Figure 6. The fluid applicator tool is inserted into the fluid within the container. Figures 1 and 6. The fluid is applied to a surface with the fluid applicator tool. Figure 6.

Claim 20: the fluid can be paint. Column 2, lines 40-45.

Claim 21: the applicator tool can be a brush. Figure 6.

Armstrong teaches all the features of these claims except the use of the strap as claimed and the adjustable features of the strap.

However, Zebrowski teaches a method for securing a user's hand to a container. Column 1, lines 50-55 and column 2, line 55 through column 3, line 20 and figures 7-10. The container has an outer surface and an inner surface. Figures 7-10 and column 2, lines 20-35. The inner surface defines a cavity therein. Figures 7-10 and column 2, lines 20-35 (for holding the beverage). One method of securing the user's hand to the container is to provide an integral handle molded in the container. Figures 1-6 and column 2, lines 30-55. To hold the container, the hand of the user is inserted between the handle and the outer surface of the container, so that the hand grips the handle. Column 2, lines 30-55. A second method of securing user's hand to the container is to provide a strap having at least one end secured to the outer surface of the container. Figures 7-10 and column 2, lines 55-65 (strap 40). The strap is mounted relative to the container to permit resilient movement of at least a portion of the strap toward and away from the container. Figures 7-10 and column 2, line 55 through column 3, line 35 (while the bottle wall is referred to as being moving, this would provide relative movement of the strap; and as well the strap would be movable and flexible to some degree as it is made of the same material as the bottle wall). The hand is inserted between the strap and the outer surface of the container to a degree sufficient to move that portion of the strap away from the container. Figures 7-10 and column 2, line 55

through column 3, line 35 (while the bottle wall is referred to as being moving, this would provide relative movement of the strap; and as well the strap would be movable and flexible to some degree as it is made of the same material as the bottle wall). The strap resiliently urges the hand against the outer surface of the container. Column 3, lines 1-10. Fluid is introduced into the container. Column 3, lines 15-25. The second end of the supportive strap can be secured to the bottom end of the container. Figure 7 and column 2, lines 55-65 (note the positioning of point 40b in the bottom wall portion 20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Armstrong to use a resilient flexible strap to hold the hand in contact with the container rather than the molded handle as suggested by Zebrowski with an expectation of providing a desirably supported container, because Armstrong teaches a hand held container to hold fluid with an integral handle, and Zebrowski teaches that when providing a hand held container to hold fluid, it is desirable to use either an integrally molded handle or to use an attached strap to hold the hand with an optional molded recess to place the hand. As the strap urges the hand against the outer surface of the container it would hold the hand in place, and thus stabilize the container with respect to the movement relative to the hand. As shown by the placement of the handle in Armstrong, the replacement of the handle area with a strap would provide the bottom of the strap on the bottom side of the container. As to the adjustability of the strap, Armstrong indicates that the user can have variously sized hands (column 3, lines 1-5) and as a result, it would have been obvious to one of

ordinary skill in the art to make the strap adjustable to allow for different sized hands given that it is the Examiner's position that it is well known in the art to make holding devices such as belts adjustable for different sized users.

5. Claims 2-6, 8-14 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Armstrong (US 4927046) in view of Boom (US 5011536).

Claim 2: Armstrong teaches a method of holding a fluid. Column 2, lines 40-45 and figures 1 and 6. A container is provided having a bottom end and a sidewall extending from the bottom end to define a main body, the container having a rim located at an upper perimeter of an opening defined by the main body of the container. Figure 5 (note area of element 8 and element 1). A supportive handle is provided that is an integral part of the container body. Figure 5 and column 4, lines 15-35. To hold the container, the hand (appendage) of the user is inserted between the handle and the outer surface of the container, so that the hand grips the handle. Figure 1 and 6 and column 3, lines 1-15. Fluid is introduced into the container. Figure 6 and column 2, lines 40-45.

Claims 5, 11, 17: a fluid applicator tool is provided. Figure 6. The fluid applicator tool is inserted into the fluid within the container. Figures 1 and 6. The fluid is applied to a surface with the fluid applicator tool. Figure 6.

Claims 6, 14: a retainer is provided for securing at least a portion of the fluid applicator tool within the container. Column 4, lines 1-20 and figure 1.

Claim 8: the appendage can be a hand of a user. Figure 1.

Claims 9, 16, 20: the fluid can be paint. Column 2, lines 40-45.

Claims 10, 21: the applicator tool can be a brush. Figure 6.

Armstrong teaches all the features of these claims except the use of the strap as claimed and the adjustable features of the strap.

However, Boom teaches a method for securing a users hand to a container. Column 2, lines 10-30. The container has an outer surface and an inner surface. Figures 1 and 3 and column 2, lines 65-68 (container 28). The inner surface defines a cavity therein. Figures 1 and 3 and column 2, lines 65-68 (for holding the wipes). One method of securing the user's hand to the container is to provide a handle affixed to the container with cylindrical members. Figures 1-3 and column 3, lines 15-50. To hold the container, the hand of the user is inserted between the handle and the outer surface of the container, so that the hand grips the handle. Column 2, lines 15-30 and column 3, lines 35-45. A second method of securing user's hand to the container is to provide a strap having at least one end secured to the outer surface of the container. Figures 4-6 and column 3, lines 50-60 (handle 44). The strap is mounted relative to the container to permit resilient (elastic) movement of at least a portion of the strap toward and away from the container. Column 2, lines 15-30. The strap would be elastic. Column 2, lines 25-30 (the resilient movement). The hand is inserted between the strap and the outer surface of the container to a degree sufficient to move that portion of the strap away from the container. Column 2, lines 15-30 and figure 3. The strap resiliently urges the



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hand against the outer surface of the container. Column 3, lines 15-30 and figure 3. The second end of the supportive strap can be secured to the bottom area of the container. Figures 4-6 (note the positioning of point 48).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Armstrong to use a resilient (elastic) flexible strap to hold the hand in contact with the container rather than the molded handle as suggested by Boom with an expectation of providing a desirably supported container, because Armstrong teaches a hand held container to hold fluid with an integral handle, and Boom teaches that when providing a hand held container, it is desirable to use a handle with a thin strap to allow holding the container with the hand and also performing other activities (column 2, lines 30-35). As the strap urges the hand against the outer surface of the container it would hold the hand in place, and thus stabilize the container with respect to the movement relative to the hand. As shown by the placement of the handle in Armstrong, the replacement of the handle area with a strap would provide the bottom of the strap on the bottom side of the container. As to the adjustability of the strap, Armstrong indicates that the user can have variously sized hands (column 3, lines 1-5) and as a result, it would have been obvious to one of ordinary skill in the art to make the strap adjustable to allow for different sized hands given that it is the Examiner's position that it is well known in the art to make holding devices such as belts adjustable for different sized users, and furthermore, Boom provides that the handle can be placed on different containers, with two separate attachments (such as 36,

38) that would be adjustable as to the location of the container where they are applied (see column 3, lines 25-35).

6. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Armstrong in view of Boom as applied to claims 1-6, 8-14 and 16-21 above, and further in view of Vaughn (US 3536285).

Armstrong in view of Boom teach all the features of these claims except the magnet for holding the applicator tool in the container.

However, Vaughn teaches that it is desirable to provide a device for holding a paint brush in a paint container. Column 1, lines 10-50. The device is a magnetic means which is secured to the wall of the paint container which magnetically holds the paint brush. See figure 3 and column 2, lines 15-50.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Armstrong in view of Boom to provide a magnetic means on the wall of the paint container to hold the paint brush as suggested by Vaughn in order to provide a desirably held paint brush, because Armstrong in view of Boom teach providing a paint container with a handle and a paint brush holding means on the handle side of the container, and Vaughn teaches a desirable paint brush holding means is a magnetic means attached to the wall of the paint container. The magnetic means would be placed on the holder side of the container, because that is where Armstrong indicates the desire to hold the paint brush.

7. The rejection of claims 22-24 under 35 U.S.C. 103(a) as being unpatentable over Armstrong in view of Boom and Vaughn as applied to claims 7 and 15 above, and further in view of Cox (US D444,929 S) is withdrawn due to the cancellation of claims 22-24.

*Response to Arguments*

8. Applicant's arguments filed April 21, 2005/May 23, 2005 have been fully considered but they are not persuasive.

As to the rejection of claims 17-21 using Armstrong in view of Zebrowski, applicant argues that the design of the holding vessel in Armstrong would effectively prevent the use of a strap to urge and stabilize a hand against the outer surface of the holding vessel, because using the strap of Zebrowski would require removal of the ledge portion of Armstrong, which along with the pistol grip handle are distinct features of the holding vessel. The Examiner has reviewed these arguments, however, the rejection is maintained. Even if a strap was placed in the location where handle 2 of Armstrong was located and the ledge remained present, the result would be a strap passing over a recessed area formed by the ledge, where the hand of the user would pass into the recessed area to hold the vessel. It would still be expected that the strap would urge the hand against the sidewall. This is supported by Zebrowski, in fact, as figures 9-10 of Zebrowski show that the strap can still be used as in figures 7-8 even

when a recessed area for the hand is provided in the surface of the container. See column 3, lines 10-20 and recess 44 in figures 9-10.

As to the rejection of claims 2-6, 8-14 and 16-21 using Armstrong in view of Boom, applicant argues that the design of the holding vessel in Armstrong would effectively prevent the use of a strap to urge and stabilize a hand against the outer surface of the holding vessel, because using the strap of Zebrowski<sup>Boom</sup> would require removal of the ledge portion of Armstrong, which along with the pistol grip handle are distinct features of the holding vessel. The Examiner has reviewed these arguments, however, the rejection is maintained. Even if a strap was placed in the location where handle 2 of Armstrong was located and the ledge remained present, the result would be a strap passing over a recessed area formed by the ledge, where the hand of the user would pass into the recessed area to hold the vessel. It would still be expected that the strap would urge the hand against the sidewall. This is supported by Boom as shown in figures 3 and 5 where there is a significant gap between the strap and the side wall of the container.

As to the rejection of claims 7 and 15 further using Vaughn, the arguments are based on the rejection using Armstrong in view of Boom above. As the Examiner has maintained the rejection of claims 2-6, 8-14 and 16-21 using Armstrong in view of Boom, the rejection further in view of Vaughn is maintained for the same reasons.

As to applicant's arguments as to Secondary Considerations: The Examiner has reviewed the declarations by Mark Bergman, Alvin Preyer, David Gerber and Steve

Holbrook, and has further reviewed the provided product brochure from Bercom. The Examiner has further reviewed applicant's arguments at pages 9-12 of the amendment (May 23, 2005). However, these declarations, arguments and the brochure do not overcome the rejection for the following reasons: (1) as to the showing of "long felt need" discussed at pages 9-10, applicant argues that the present invention came into response to a long felt need to reduce fatigue and hand cramping in the painting industry. However, the following features required for a showing of long felt need have not been provided (see the discussion in MPEP 716.04 as to this issue) - a) applicant has not provided objective evidence that an art recognized problem existed in the art for a long period of time without solution, and that others failed to solve this problem with prior unsuccessful attempts. While applicant noted that a problem exists in the painting industry, there is no showing that it existed in the art for a long period of time with no other solution and that there was a failure by others to solve this problem. b) applicant has not provided any discussion that this problem was not solved by others in another form. c) furthermore, while applicant refers to a problem in the painting industry, the claims are not so limited. For example, independent claim 2 is merely "a method of holding a fluid". Thus, the references to the painting industry is not commensurate in scope with the claims. (2) as to the showing of "Skepticism by Experts" discussed at page 10, applicant argues that others (as cited in the declarations) were skeptical about the viability of the product. The Examiner has reviewed the declarations, however, skepticism that the product would work does not appear to have

been shown. Rather, the skepticism appears to be directed to whether the product would sell (note paragraph 2 of Mr. Gerber's declaration, for example, and paragraphs 3-5 of Mr. Preyer's declaration). Unexpected sales of a product, while evidence of its popularity, do not provide evidence of the innate workability of the invention. (3) as to the showing of Commercial Success, as discussed at pages 11-12, the Examiner has reviewed the declarations, brochure and arguments, however, the required showing of commercial success sufficient to overcome the rejection of the claims has not been made. Specifically, a) applicant has not provided evidence of commercial success commensurate in scope with the claims (See MPEP 176.03(a)). Applicant has provided showings to the commercial sales of the product as the "HANDy Paint Pail" and all declarations are concerned with its sales specifically to the paint market. However, the claims of this case are not so limited. Note that claims 2-4, for example, provide a method of holding any fluid (such as a drink, or cleaning fluid, etc.) No claims are provided specifically for using paint materials with an applicator brush. Furthermore, the claims are to methods of using the container device, and applicant has provided no showing as to how the method of using corresponds to the commercial success. b) applicant further has not provided evidence that the commercial success is directly derived from the invention claimed. As discussed in MPEP 716.03(b), sales can be tied to advertising, etc.

### *Conclusion*


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (571) 272-1413. The examiner can normally be reached on M-F(6:00-3:30) with the First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and for After Final communications.

Other inquiries can be directed to the Tech Center 1700 telephone number at (571) 272-1700.

Furthermore, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
KATHERINE BAREFORD  
PRIMARY EXAMINER